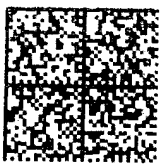


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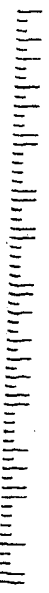


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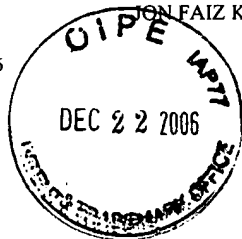
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/873,597	06/12/1997	JON FAIZ KAYYEM	A-64558-1	2066

7590 12/20/2006  
Robin M. Silva  
FLEHR HOHBACH TEST  
ALBRITTON & HERBERT, LLP  
Four Embarcadero Center, Suite 3400  
San Francisco, CA 94111-4187



EXAMINER  
FORMAN, BETTY J

ART UNIT 1634  
PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/20/2006	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.



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## FINAL ACTION

### *Status of the Claims*

1. This action is in response to papers filed 10 October 2006 in a Terminal Disclaimer was submitted. The rejection under obviousness-type double patenting over U.S. Patent No. 7,014,992 is withdrawn in view of the Terminal Disclaimer.

The previous rejection under obviousness-type double patenting over currently allowed application 09/452,277 is maintained.

### *Double Patenting*

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 19-22, 26, 33-35 and 39-45 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 22, 26-27, 30-35, 37-45 of copending Application No. 09/452,277 in view of Okano et al (U.S. Patent No. 5,434,049. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to electrode immobilized nucleic acids wherein the nucleic acids are immobilized covalently via an insulator. The claim sets merely

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differ in the arrangement of limitations within the claim sets and further in that the instant claims are drawn to two electrodes. However, multiple electrode substrates for nucleic acid immobilization was well known in the art at the time the claimed invention was made as taught by Okano et al who teach that multiple electrodes provide for simultaneous detection of a plurality of nucleotide targets (Abstract and Column 2, lines 35-57). It would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the '277 electrode by using additional electrodes as taught by Okano et al. One of ordinary skill in the art would have been motivated to do so for the expected benefit of for detecting of a plurality of nucleotide targets simultaneously as taught by Okano et al (Abstract and Column 2, lines 35-57).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### **Response to Comments**

Applicant requests that the above rejection be held in abeyance until allowable subject matter has been found in the instant application or the '277 application. A notice of allowance was mailed on 26 January 2006 for the '277 application. The rejection is maintained and made final.

#### **Conclusion**

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BJ Forman whose telephone number is (571) 272-0741. The examiner can normally be reached on 6:00 TO 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla can be reached on (571) 272-0735. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

  
BJ Forman, Ph.D.  
Primary Examiner  
Art Unit: 1634  
December 13, 2006